



Attorney Docket No. 30311/35918

IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

Applicants: Drmanac *et al.*) I hereby certify that this paper is being
Serial No.: 09/479,608) deposited with the United States Postal
Filed: January 6, 2000) Service as first class mail, postage prepaid,
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PROBES) August 20, 2002
Group Art Unit: 1631)
Examiner: L. Clow) Nabeela McMillian
Reg. No. 43,363
Agent for Applicants

RESPONSE TO OFFICE ACTION
DATED MAY 21, 2002

Commissioner for Patents
Washington, DC 20231

Sir:

This paper is filed in response to an Office Action mailed from the United States Patent and Trademark Office on May 21, 2002. This response is due on August 21, 2002, and as such is timely filed. No fees are believed to be due; however, should any fees be properly due in connection with the filing of this document, the Commissioner is hereby authorized to deduct any such fees from Marshall, Gerstein & Borun account number 13-2855.

In light of the remarks presented below, Applicants request reconsideration of the application.

I. Status of Claims

Claims 1-35 are pending in the instant case and all stand rejected under 35 U.S.C. §103(a). For the Examiner's convenience, Applicants have attached a clean copy of all pending claims(Appendix A).

II. Response to Objections Regarding Informal Drawings

In the aforementioned communication from the Examiner, the Applicants were informed that Figures 1 and 4 were unacceptable because they did not meet the margin requirements set forth in 37 CFR 1.84(g). Formal versions of Figures 1 and 4 are submitted herewith in Appendix B.

III. Response to Objections Regarding Specification

The Examiner informed Applicants that the substitute specification filed on August 2, 2001 was not entered because it did not conform to 37 CFR §1.125(b), which required a marked-up version of the substitute specification showing all changes. A marked-up version of the substitute specification filed on August 2, 2001 is included in Appendix C. As stated in a previous correspondence, amendments were made to the specification only to include references to the previously requested Sequence Listing, and as a result, the amendments include no new matter. Applicants believe that this submission in conjunction with previous relevant submissions comply with the requirements of 37 CFR §1.125. Applicants therefore respectfully request that the substitute specification be entered in the application.

IV. Response to Rejection of Claims under 35 U.S.C. §103(a)

Claims 1-35 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Alfenito (U.S. Patent No. 6,355,419, hereinafter "Alfenito"). According to the Examiner, Alfenito teaches methods for preparing nucleic acid pools useful in hybridization studies and an improved method of identifying a nucleic acid and/or its representation in a sample, and in doing so, teaches all of the limitations included in the rejected Claims.

In response, Applicants traverse the rejection, at least, because Alfenito document is not available as prior art against the instant application. Attached herewith is a statement from Applicant's representative establishing common ownership of Alfenito and the instant application at the time the instant application was filed. (See Appendix D).

According to MPEP §715.01(b),

"Where, however, a rejection is applied . . . in an application filed on or after November 29, 1999, under 35 U.S.C. 102(e)/103 using the reference, a showing that the invention was commonly owned, or subject to an obligation of assignment to the same person at the time the later invention was made would preclude such a rejection or be sufficient to overcome such a rejection."

As shown in the documents found in Appendix D, the inventor of the 09/067,317 application (which later issued as U.S. Patent No. 6,355, 419, *i.e.*, Alfenito) assigned the application to Hyseq, Inc. The assignment can be found at reel/frame number 9377/0102. Hyseq, Inc. subsequently assigned its rights to the Alfenito invention to Callida Genomics, Inc. This assignment was recorded at United States Patent and Trademark Office reel/frame number 012716/0954. Likewise, the present application, U.S. patent application number 09/479,608, was assigned by its inventors to Hyseq, Inc. (see reel/frame number 010716/0409). Subsequently, Hyseq assigned its rights to 09/479,608 to Callida Genomics, Inc. on October 24, 2001. A request for recordation has been submitted to the United States Patent and Trademark Office. All documents regarding this latter assignment is also included in Appendix D.

Because the Alfenito Patent and the instant application were both commonly owned and subject to an obligation of assignment to the same entity, *i.e.*, Callida Genomics, Inc., when the instant Application was filed, Applicants submit that the rejection under 35 U.S.C. §103 is precluded pursuant to MPEP §715.01(b).

V. Conclusion

Applicants believe that Figures 1 and 4 and the substitute specification now meet the relevant requirements and submit that pending claims 1-35 are in condition for allowance. The Examiner is invited to contact the undersigned with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,
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